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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,776	04/13/2006	Masahiro Yoshioka	0760-0353PUS1	3792
2292 7590 01/03/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
PAK, HANNAH J				
ART UNIT		PAPER NUMBER		
1764				
NOTIFICATION DATE		DELIVERY MODE		
01/03/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/575,776

Applicant(s)

YOSHIOKA ET AL.

Examiner

Hannah Pak

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/28/2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9,11-15 and 17-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3,5-7,9,11-15 and 17-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/28/2010 has been entered.

Response to Amendment

2. The applicants' amended claim 1 to further limit their black composition to having a specific resin, e.g., an acrylic resin, a particular weight ratio of titanium nitride oxide to the acrylic resin, and a specific transmittance of i-ray, e.g., ultraviolet light, is supported at page 13, lines 1-5, page 18, lines 8-15, and page 9, lines 16-17, respectively, of the specification as originally filed. Thus, no new matter is introduced.

3. The applicant also amended claim 1 to further limit R_1 value from greater than 0.70, but less than or equal to 0.82, which is supported by the specification as originally filed. The specification as originally filed describes at page 8, line 10, a generic range of $R_1 > 0.70$ and provides at page 24, lines 26-27, Example 1, R_1 value of 0.82. Since the claimed range is supported by the generic range and example in the original application disclosure in accordance with In re Wertheim cited in MPEP § 2163.05, III, no new matter is present.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 9, 11-15, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) in view of Nakamura et al. (US 6,582,862).

Tsukamoto et al. disclose a black coating composition useful as a resin black matrix for color filters in liquid crystal displays (Paragraphs [0002] and [0005]). The black coating composition taught by Tsukamoto et al. comprises titanic acid nitrides or titanium black having the structure of TiNO (titanium nitride oxide), a solvent, a photosensitive resin, including an acrylic resin and a polyimide resin, and various additives, such as carbon black (Paragraphs [0009], [0012], [0017], and [0021]). Furthermore, Tsukamoto et al. disclose X-ray intensity ratio R having the following formula (Paragraphs [0011] and [0012]):

$$R=I_3/(I_3+1.8 \times (I_1+1.8 \times I_2));$$

wherein R is 0.28 or more, I_1 represents the maximum diffraction line intensity of the titanic acid nitrides when the angle of diffraction 2 theta, determined by using a X line source CuK alpha rays, is 25-26 degrees, I_2 represents the maximum diffraction line intensity of the titanic acid nitrides when the angle of diffraction 2 theta is 27-28

degrees, and I_3 represents the maximum diffraction intensity of the titanate acid nitrides when the angle of diffraction 2θ is 36-38 degrees. As is apparent from the above, R corresponds to the claimed R_1 and embraces a value inclusive of the claimed R_1 value. I_3 is identical to the claimed I_3 . I_1 and I_2 values taught by Tsukamoto et al., therefore, necessarily overlap with the claimed I_1 and I_2 values, i.e., the claimed R_2 value, to arrive at the R value of 0.28 or more.

Although Tsukamoto et al. do not mention the specific weight ratio of the titanium nitride oxide to acrylic resin, Tsukamoto et al. teach the importance of using the appropriate weight ratio for given titanate acid nitride to a polymer resin to obtain high optical density (OD) value and high resistance, and exemplifies titanate acid nitride/polyimide (which is interchangeably used with another photosensitive resin, such as acrylic resin) in the weight ratio of 90/10 to 40/60 (Paragraph [0018]). Thus, it can be inferred from this disclosure that the weight ratio of the titanium acid nitride/acrylic resin, not only overlaps with the claimed weight ratio of 75/25 to 60/40, but also, is a results-effective variable. Accordingly, it would have been obvious to one of ordinary skill in the art to employ the optimum or workable weight ratio of titanate acid nitride to acrylic resin in the black coating composition with a reasonable expectation of successfully providing high resistant properties and high OD value, such as greater than 4.0, *see MPEP* § 2144.05, IIB.

As to claims 1-2, 11-12, and 15, Tsukamoto et al. do not mention the specific X-ray intensity ratio R and optical density (OD value) ranges. As mentioned above, Tsukamoto et al. teach X-ray intensity ratio R of 0.28 or more, which overlaps with those

claimed, e.g., R_1 value of 0.70-0.82 and R_1 of not less than 0.80. Moreover, Tsukamoto et al. teach their black coating composition having a more preferably OD value of 4.0 or more (per 1 micrometer of 1 of film pressure (Paragraph [0023]), which overlaps with those claimed, e.g., OD value of not less than 4.4 per 1 μm of film thickness. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the invention was made, since it has been held that choosing the overlapping portion of the ranges taught by Tsukamoto et al., and the ranges claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *MPEP* § 2144.05.

As to functionally defined OD value, i.e., transmittance of i-ray ultraviolet light through a resin black matrix obtained from said black composition is more than 0.2% when the OD value is 2.0, recited in claim 1, there is reasonable basis to believe that the black coating composition suggested by Tsukamoto et al. also possess the OD value, which at least overlap with the claimed functionally defined OD value, since Tsukamoto et al. teach its black coating composition having the claimed ingredients as mentioned above.

As to photocuring property and components recited in claims 1 and 26, Tsukamoto et al. teach using a photosensitive resin in their black coating composition useful for color filters in liquid crystal display (LCD) (Paragraph [0022]). Although Tsukamoto et al. do not specifically mention photocuring its black coating composition, the term "photosensitive resin" is synonymous with photocurable resin according to Col. 1, lines 15-30 of Nakamura et al. Nakamura et al. also teach a coating composition used in color filters of liquid crystal display (LCD) (Col. 8, lines 55-62) comprising a

photosensitive resin, inclusive of those taught by Tsukamoto et al., can be photo-cured, via introducing a photoinitiator and photopolymerizable monomer (Col 9., lines 5-20, Col. 13, lines 51-55, and Col. 47, lines 35-65). Thus, it would have been obvious to one of ordinary skill in the art include the photoinitiator and photopolymerizable monomer as taught by Nakamura et al. in the black composition of the type discussed in Tsukamoto et al., motivated by a reasonable expectation of successfully providing desired photocurable properties, such as that claimed, useful for preparing color filter of LCD.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) in view of Nakamura et al. (US 6,582,862) as applied to claims 1-2, 9, 11-15, and 19-26, and further in view of Tanaka et al. (US 2004/0236006).

The disclosures with respect to Tsukamoto et al. and Nakamura et al. in paragraph 4 are discussed above. Although they broadly mention using any solvent in the black coating composition (Paragraph [0009], they do not mention the specific properties, i.e., boiling point temperature and viscosity, of its solvent.

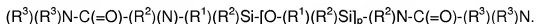
However, Tanaka et al. disclose employing a solvent, e.g. 3-methoxy-3-methyl-1-butanol, which according to page 12, lines 15-18, of the present specification has the claimed boiling point and viscosity, in a black composition suitable for preparing color filters of LCD to obtain desired uniform coating (Paragraphs [0019], [0022], [0040] and [0043] of Tanaka et al.).

Given the above teachings, it would have been obvious to one of ordinary skill in the art to use the solvent having the claimed properties as taught by Tanaka et al. as the solvent in the black coating composition of Tsukamoto et al., motivated by a reasonable expectation of successfully providing advantageous uniform coating.

6. Claims 5-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) in view of Nakamura et al. (US 6,582,862) as applied to claims 1-2, 9, 11-15, and 19-26 above, and further in view of Hedaya et al. (US 4,208,492).

The disclosures with respect to Tsukamoto et al. and Nakamura et al. in paragraph 4 are discussed above. They do not mention the addition of a specific siloxane compound as required by the claims.

However, Hedaya et al. disclose employing a siloxane polymer compounded with other fillers and additives, such as those taught by Tsukamoto et al (e.g., carbon black), useful for a wide variety of applications, which exhibits excellent mechanical properties, including good tensile strength and elongation, good resilience, and thermal stability and has the formula (Col 1, lines 15-25, Col. 3, lines 5-10, and Col. 5, lines 45-51):



The above formula corresponds to the claimed formula from right to left, wherein p value of 0-4 corresponds to n, R^1 - R^2 is the same as the claimed R^1 and R^3 - R^6 , representing alkyl groups (such as methyl or ethyl), and R^3 corresponds to the claimed tetramethylene bonds, representing alkylene groups (Col. 3, line 40-Col. 4, line 40).

The above formula also contains amide bond and an ester bond, which corresponds to the claimed R^2 (Col. 5, lines 45-50).

Given the above teachings, it would have been obvious to one of ordinary skill in the art to employ the siloxane polymer of Hedaya et al. compounded with other fillers and additives in the composition taught by Tsukamoto et al. to produce a wide variety of applications, motivated by a reasonable expectation of successfully obtaining desired mechanical properties, including good tensile strength and elongation, good resilience, and thermal stability.

Response to Arguments

7.

(A)

Applicants' Argument: The applicants argue that the composition of Tsukamoto cannot exhibit any photocuring properties (see Pages 10-11 of the Applicants' Remarks). In support of such arguments, the applicants submitted a declaration under 37 CFR 1.132 executed by Mr. Ryo Nagase, a co-applicant of the present invention. The declaration compares Tsukamoto's composition without a photoinitiator and photopolymerizable monomer, which are important components for photo-curing and applicants' composition with a photoinitiator and photopolymerizable monomer.

Examiner's Response: however, this showing is not truly comparative since no photocuring agents, i.e., photoinitiator and photopolymerizable monomer, were used in the black composition of Tsukamoto et al. As indicated above, for purposes of

photocuring the photosensitive resin, such as those taught by Tsukamoto et al. and the claims, the presence of the photocuring agents, such as photoinitiator and photopolymerizable monomer, is known to be critical. As also indicated above, it is apparent from the teachings of Nakamura or Tanaka, the claimed photocurable properties is reasonably expected from adding the photocuring agent, such as the photoinitiator and photopolymerizable monomer, in the black composition taught by Tsukamoto. Thus, the declaration showing is not sufficient to rebut the prima facie case of obviousness established by the teachings of references cited.

(B)

Applicants' Argument: The applicants argue that the composition of Tsukamoto does not exhibit the OD value of not less than 4.4 per 1 um of thickness (see Pages 10-11 of the Applicants' Remarks). The applicants again rely on the same declaration for support.

Examiner's Response: However, the applicants have not shown that the black composition taught by Tsukamoto does not have the OD values inclusive of those claimed. In particular, Tsukamoto teaches OD values of their black composition can be lower or identical to that claimed, e.g., preferably OD value of more than 4.0. In other words, Tsukamoto teaches overlapping OD values. The declaration only shows this teaching by exemplifying one of the black compositions taught by Tsukamoto within its OD range value, e.g., lower end. Accordingly, the declaration fails to compare the higher OD value taught by Tsukamoto with the claimed OD value.

(C)

Applicants' Argument: The applicants contend that the claimed invention imparts unexpected advantageous properties, i.e., high OD value and high adhesion properties (see Pages 9-12 of the Applicants' Remarks). The applicants further rely on the examples on pages 24-29 of the present specification as support.

Examiner's Response: The applicants' argument and examples in the present specification directed to alleged unexpected results do not overcome the prima facie case of obviousness established in the record. While it is true that a showing of unexpected results can rebut any inference of obviousness established by the prior art of record, the applicants have the burden of showing that the claimed invention as whole imparts such unexpected results. (1) This burden requires the applicants to show that the alleged improvement in properties is actually unexpected. However, the applicants have not carried this burden since Tsukamoto shows the alleged improvement in high OD value and other properties would be expected from optimizing the weight ratio of the titanium nitride oxide to acrylic resin. (2) The examples in the present specification do not include any direct comparison in the form of experiments between the claimed invention against a prior art reference, e.g., Tsukamoto, wherein the actual difference, is shown to impart unexpected results. This showing is especially important since, like the applicants, Tsukamoto teaches a black composition having a high OD value comprising a solvent, and a titanium nitride oxide/acrylic resin in the claimed weight ratio. Moreover, the declaration mentioned above is also not sufficient is not truly comparative for the reasons stated above. Accordingly, the applicants fail to rebut the prima facie case of obviousness established in the record.

(D)

Applicants' Argument: The applicants argue that Hedaya fails to make up the deficiencies of Tsukamoto et al. (see Page 12 of the Applicants' Remarks).

Examiner's Response: While Hedaya does not disclose all the features of the claimed invention, it is utilized as a teaching reference and therefore, it is not necessary for such secondary reference to contain all the features of the presently claimed invention. Rather, this reference teaches a certain concept, i.e., addition of a specific siloxane polymer, and in combination with the other references, disclose the presently claimed invention.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak
Examiner
Art Unit 1764

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